

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-5, 8, 9 and 11-17 remain in the application and claim 1 is independent. The Office Action dated August 19, 2010 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 1-9 and 11-17 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite because the phrase “less than a size of a head of a tick” in claim 1 is alleged to be unclear, and correction is required. This rejection is traversed as unreasonable. MPEP § 2173.05(b) specifically indicates the

“fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packaging, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.”

The instant invention is directed to a tick puller and the Examiner has had no difficulty in understanding the features of the invention, searching the prior art or examining the claims in view of the art found. To raise this issue now would appear untimely. Moreover, the statement that this language will be assumed to mean “relatively thin” is not accurate as that is not what the claim says, nor what the specification says. The specification makes clear that the thickness of the cutter blade at the outer opening must be less than the thickness of a head of a tick.

The test for compliance with the second paragraph of 35 U.S.C. §112, as stated in *Miles Lab., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), *cert. denied*, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. See, also, *In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which

stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct. See, also, *In re Warmerdam*, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). This claim recites "a size of a head of a tick." Use of that term in a claim does not render the claim indefinite if the specification provides a standard whereby one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co., Inc. v. Industrial Coating and packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-4 (Fed. Cir. 1984). Clearly that is the case.

The second paragraph of 35 U.S.C. §112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity, *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

Applicant respectfully submits that the claims fully comply with 35 U.S.C. §112, second paragraph, as they stand and because one of ordinary skill in the art can readily determine the metes and bounds of the invention. These claims, when read in the art of tick pullers, provide clear language that describes the invention and would permit one in the art to compare these claims to other tick pullers. That is all that is required by the law. Reciting the relationship between the thickness of the cutter blade at the outer opening as compared to the size of a tick head is a feature of the invention. To require the claim to recite otherwise would prevent applicant from particularly pointing out and distinctly claiming the subject matter that Applicant regards as his invention. Reconsideration and withdrawal of the rejection are respectfully requested.

Legal Standard for Anticipation and Obviousness Rejections

According to MPEP § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

Similar to anticipation rejections, in order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1395 (2007) (citing *In Re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Claim Rejections – 35 U.S.C. § 103

Claims 1-6, 9 and 11-17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Browne in view of U.S. Pat. 5,884,900 to Gobeil et al. (“Gobeil”). Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Browne in view of Gobeil, and further in view of Graue. These rejections, insofar as they are applicable to these claims, are respectfully traversed.

While not conceding the appropriateness of the Examiner’s rejection, but merely to advance prosecution of the instant application, Applicants respectfully submit that independent claim 1 has been amended to recite a combination of elements in a tool for removing ticks including, *inter alia*, each side face comprises a lowermost part that extends essentially perpendicularly from the bottom face and is connected to the concave engagement face, and at least for a distance, the lowermost part of the side face is increasing in height, seen from the edge to the internal assembly point. Applicant respectfully submits that this combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Browne, Gobeil and Graue.

Applicant respectfully submits that this combination of references proposes to improperly combine unrelated references, one of which references explicitly indicates should not be combined with tools having handles, such as are present in the other two references. And even if the combination were to be made, which we do not admit is obvious, it fails to show or suggest the claimed invention.

The rejection now proposes to combine the fastener removal tool of Gobeil with the tack puller of Browne. Applicant respectfully points out that Gobeil clearly indicates in column 1, lines 17-27, that “Currently available fastener removal tools or nail pullers are incompatible” with tools for removal of snap fasteners. Gobeil discloses features of a snap fastener remover.

Thus, features of fastener removal tools such as Gobeil cannot be combined with nail pullers such as Browne because the handles provide “concentrated loading.” In addition, the rejection admits that Browne “fails to disclose the blade thickness as claimed”. Further in addition, MPEP § 2143.01, sections V and VI prohibit a combination of two references where the incorporation of features from the second reference renders the base reference “unsatisfactory for its intended purpose” or results in a “change [of] the principle of operation of the reference.” Gobeil desires to eliminate the handle to eliminate the “concentrated loading.” Combining Browne and Gobeil would violate both sections V and VI of § 2143.01.

In attempt to address the feature of the thickness of a tick head, the rejection appears to rely upon “see attached references cited”, but which references are not applied. Applicant cannot discuss or rebut distinctions of references not applied. If these other references are being applied, the instant rejection should be withdrawn and reformulated so that Applicant will be permitted to rebut what has not yet been put on the record. Neither Browne nor Gobeil show or suggest this feature of the invention which requires and claims the thickness of the cutter blade at the outer opening is less than a size of a head of a tick.

The rejection turns to Graue, another tack puller, in an attempt to address the specific shape of the side faces. Graue also fails to show or suggest the thickness of the cutter blade at the outer opening is less than a size of a head of a tick. Moreover, by adding a second tack puller to a combination with another tack puller and an aircraft snap fastener remover, in an attempt to address the features of a tick remover, it is submitted that the rejection is using the instant claims as a template rather than establishing *prima facie* obviousness.

Applicant respectfully submits that the combination of elements as set forth in independent claim 1 is not disclosed or made obvious by the prior art of record, including Browne, Gobeil and Graue, for the reasons explained above. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

With regard to dependent claims 2-5, 8, 9 and 11-17, Applicant submits that dependent claims 2-5, 8, 9 and 11-17 depend, either directly or indirectly, from independent claim 1 which is allowable for the reasons set forth above, and therefore claims 2-5, 8, 9 and 11-17 are allowable based at least on their dependence from claim 1. Reconsideration and allowance thereof are respectfully requested.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.


Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

Dated: November 19, 2010

Respectfully submitted,

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